

Applicants : Jan Geliebter, et al.  
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#### REMARKS

Claims 50-59 are pending and under examination in the subject application.

#### Rejections under 35 U.S.C. §112, First Paragraph

Claims 50-54 and 58-59 are rejected under the written description and enablement requirements of 35 U.S.C. §112, first paragraph. In this regard, the rejection appears to be based on the sentence spanning pages 27-28 of the specification that the Examiner interpreted as disclaiming or limiting applicants' invention solely to the use of DNA encoding maxi-K and  $K_{ATP}$  for inducing relaxation of penile smooth muscle. Applicants respectfully traverse this rejection, and maintain that the specification provides a written description and an enabling disclosure for the claimed invention.

Attached hereto is a Declaration of Drs. George J. Christ and Arnold Melman under 37 C.F.R. §1.132 (3 pages). Drs. Christ and Melman are two of the coinventors of the claimed subject matter. In the enclosed Declaration, Drs. Christ and Melman discuss the meaning of the sentence spanning pages 27-28 of the specification. In particular, in paragraph 5 of the Declaration, Drs. Christ and Melman state that "This sentence was meant to characterize the state of the art, and more specifically, the physiological importance of endogenous maxi-K and  $K_{ATP}$ , based on pre-existing experimental and clinical data. This sentence was not meant to limit the invention, which relies on the use of nucleic acid encoding exogenous potassium channels to regulate corporal smooth muscle tone. Again, maxi-K and  $K_{ATP}$  are provided in the application as examples of exogenous potassium channels that can be used to regulate corporal smooth muscle tone." Earlier in the Declaration, in paragraph 4, Drs. Christ and Melman state that "As of the filing date of the application, the inventors considered their

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invention to include the use of a nucleic acid encoding an exogenous potassium channel generally for regulating corporal smooth muscle tone, and the use of nucleic acid encoding exogenous potassium channel subtypes maxi-K and  $K_{ATP}$  were provided as specific examples.”

Accordingly, in view of the above remarks and the enclosed Declaration, as well as remarks already of record regarding these grounds of rejection, reconsideration and withdrawal of the rejections under 35 U.S.C. §112, first paragraph, are respectfully requested.

#### Allowable Subject Matter

The Examiner indicated that claims 55-57 contain allowable subject matter, but are objected to as being dependent upon a rejected base claim. Applicants thank the Examiner for this indication of allowable subject matter, and respectfully request that the Examiner reconsider the allowability of all the pending claims in view of the remarks made hereinabove.